

### REMARKS

The Examiner has subjected this application to restriction under 35 U.S.C. 121. The Examiner has formed two groups of claims, the first incorporating claims 1-35 (Group I), drawn to a multilayer film, and the second incorporating claims 36-42 (Group II), drawn to a process for making the multilayer film. The Examiner has asserted that these groups of claims represent distinct inventions and may properly be restricted. During a telephone conversation with the Examiner on November 16, 2005, Applicants provisionally elected claim Group I directed to claims 1-35 for examination. This election is hereby affirmed. However, the restriction requirement is traversed. It should be noted, the Commissioner may statutorily require the election of inventions "[i]f two or more independent and distinct inventions are claimed in one application." In the instant case the Examiner is alleging that the inventions of groups one and two are distinct, although absolutely no showing of such distinctness has been made.

The Examiner's attention is directed to 37 C.F.R. 1.141(b) where allegedly different classes of inventions may be included and examined in a single application provided they are so linked as to form a single inventive concept. Please note that claims for a product are specifically authorized for examination together with claims for one process specially adapted for the use of that product. This is exactly the type of case for which the rule was promulgated, i.e., to avoid burdensome and unnecessary restrictions. It is also asserted that the requirement to restrict the present application would be an unnecessary burden upon the Applicants and the Examiner's failure to follow the mandates of the statute and regulation would be a denial of due process. For these reasons it is respectfully urged that the restriction requirement be rescinded.

In addition since the method claims contain all of the limitations of the article claims, the method claims should be rejoined under *In Re Ochiai*, 37 USPQ2d 1127 and *In re Brouwer*, 37 USPQ 1663.

The Examiner has objected to the drawings because the serial number of the application does not appear on the drawing page. It is respectfully submitted that the objection is improper. The standards for drawings are set forth in 37 C.F.R. § 1.84. While subsection 37 C.F.R. § 1.84(c) states that identifying indicia "*should*" be provided on drawing sheets, this is not a mandatory requirement under the patent rules, and an Applicant's failure to include such identifying indicia is not a proper ground of objection. Accordingly, it is respectfully requested that the objection be withdrawn.

The Examiner has objected to the abstract of the disclosure because the serial number of the application does not appear on the abstract page. It is respectfully submitted that the objection is improper. The requirements for the abstract of the disclosure are set forth in 37 C.F.R. § 1.72 and MPEP § 608.01(b), neither of which includes a requirement for the serial number of the application to appear on the abstract page as the Examiner requires. It is respectfully submitted that this is not a mandatory requirement under the patent rules, and an Applicant's failure to include such identifying indicia is not a proper ground of objection. Accordingly, it is respectfully requested that the objection be withdrawn.

The Examiner has also objected to the Applicants' incorporation by reference of U.S. patents 4,677,017; 5,087,677; 5,139,878, 5,270,393; 5,371,158; 5,422,409; 5,439,973; 5,516,841; 5,569,711; 5,585,433; 5,876,814 and 5,880,241, stating that the incorporation is ineffective because these patents do not appear on an Information Disclosure Statement (IDS). It is respectfully submitted that the objection is improper. The requirements for incorporation by reference are set forth in 37 C.F.R. § 1.57 and MPEP § 608.01(p), neither of which includes a requirement for the incorporated patents to be included on an IDS as the Examiner requires. It is respectfully submitted that this is not a mandatory requirement under the patent rules, and an Applicant's failure to include such identifying indicia is not a proper ground of objection. Accordingly, it is respectfully requested that the objection be withdrawn. Nonetheless, for the Examiner's convenience, Applicants

hereby submit a new Information Disclosure Statement (IDS) together with this Amendment including the above U.S. patents, as the Examiner has requested.

In addition to the above references, three new references have been submitted in the new IDS: U.S. patent 5,936,037 to Tasaka; U.S. patent 6,582,859 to Quinn, et al.; and Japanese Patent Application JP 09-302319. The fee for submission of this new IDS as set forth in 37 C.F.R. § 1.17(p) is submitted herewith. The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

With regard to the above amendment, in claims 1 and 30, the scope of the adhesive tie layer has been limited to consist essentially of a combination of at least one tackifier and at least one unmodified ethylene/alpha-olefin copolymer. This feature was originally presented in claims 14 and 31, which are now canceled. Claim 1 has been further amended to limit the scope of the thermoplastic polymer layer to exclude polyesters in view of the disclosure of JP 09-302319 referenced above. Claim 30 has been further amended to broaden the scope of the thermoplastic polymer layer which is attached to the claimed polypropylene layer. While this amendment does broaden the scope of claim 30, the claims is narrower than original claim 1, and is fully supported by the specification. New claims 43-45 have been added as dependent from amended claim 30. New claims 46-52 have also been added for a five layer structure that is neither taught nor suggested by the prior art.

The Examiner has rejected claims 1-5, 8-13, 16-17, 19-20, 21-23, 26, 28-30 and 32-35 under 35 U.S.C. 102(b) over U.S. patent 5,532,030 to Hirose et al. It is respectfully submitted that the rejection has been overcome by the instant amendment. Claim 1 has been amended to include the limitations of claim 14, and claim 30 has been amended to include the limitations of claim 31. Neither claim 14 nor claim 31 stands rejected under

35 U.S.C. 102(b). Specifically, Hirose et al. fails to teach multilayer films formed with an adhesive that consists essentially of a combination of an unmodified ethylene/alpha-olefin copolymer and a tackifier. The adhesive layer of Hirose et al. is described at col. 33, line 4-col. 34, line 26. The adhesive layer may comprise a modified polyolefin or an unsaturated polyolefin, wherein the *modified polyolefin* may comprise an ethylene/alpha-olefin copolymer. The reference does not describe unmodified polyolefins that may comprise an ethylene/alpha-olefin copolymer. Accordingly, it is respectfully submitted that the rejection is overcome.

The Examiner has rejected claims 6-7 under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. and further in view of U.S. patent application 2003/0008152 to Tsai et al. It is respectfully submitted that the rejection is incorrect and should be withdrawn.

The remarks regarding Hirose et al. are repeated from above. The Tsai et al. reference discloses multilayer moisture barrier films useful as packaging materials. More particularly, Tsai et al. describes multilayer barrier films that comprise a fluoropolymer layer attached to a cyclic olefin polymer layer via an intermediate adhesive tie layer. Tsai et al. fails to disclose the adhesive compositions of the presently claimed invention. Specifically, Tsai et al. fails to teach an adhesive tie layer that comprises a combination of a tackifier and an ethylene- $\alpha$ -olefin copolymer. The Examiner has applied the Tsai et al. reference for disclosure of the use of adhesive tie layers to attach additional polymer layers, as described in claims 6 and 7 of the invention. However, the Tsai et al. reference fails to overcome the differences between the claimed invention and Hirose et al. Particularly, it is respectfully submitted that there is no teaching or suggestion in either reference to form a multilayer film wherein each adjacent film layer is attached via an intermediate adhesive tie layer which comprises a combination of a tackifier and an ethylene/alpha-olefin copolymer, or more particularly, an unmodified ethylene/alpha-olefin copolymer. Further, it is submitted that one skilled in the art would not look to Tsai et al. in combination with Hirose et al. for the purpose of forming a multilayered film as taught by claims 6-7.

Applicants respectfully submit that the Examiner is reconstructing the art in light of Applicant's disclosure. An invention cannot be deemed unpatentable merely because, in a hindsight attempt to reconstruct the invention, one can find elements of it in the art; it must be shown that the invention as a whole was obvious at the time the invention was made without knowledge of the claimed invention. When selective combination of prior art references is needed to make an invention seem obvious, there must be something in the art to suggest that particular combination other than hindsight gleaned from the invention itself, something to suggest the desirability of the combination. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1438 (CAFC 1988). Such a suggestion is absent in the cited references.

The point in time that is critical for an obviousness determination is at the time the invention. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. For the foregoing reasons, it is submitted that the rejection is incorrect and should be withdrawn.

The Examiner has rejected claims 14 and 31 under 35 U.S.C. 103(a) over Hirose et al. in view of U.S. patent 6,656,601 to Kawachi et al. It is respectfully submitted that the rejection has been overcome by the instant amendment. The claims have been amended to limit the scope of the adhesive composition to consist essentially of an unmodified ethylene/alpha-olefin copolymer and a tackifier. Neither Hirose et al. nor Kawachi et al. teach or suggest multilayer films having the adhesive tie layer as amended.

The prior remarks regarding Hirose et al. are repeated herein. As the Examiner acknowledges, Hirose et al. fails to teach an adhesive which includes an unmodified ethylene/alpha-olefin copolymer. To fill this void, the Examiner applies Kawachi et al. which teaches five different adhesive compositions that may be used as adhesives in films. Particularly, Kawachi et al. teaches adhesive compositions which each of which include a modified ethylene/alpha-olefin copolymer, and some of which additionally include an unmodified ethylene/alpha-olefin copolymer. For example, the first adhesive composition of Kawachi et al. comprises 50-99 wt. % of a modified ethylene/alpha-olefin copolymer (see, for example, col. 3, lines 2-17);. Their second adhesive composition requires a modified ethylene/alpha-olefin copolymer or a modified ethylene homopolymer (see, for example, col. 3, lines 61-65). Their third adhesive composition comprises 50 to 95% by weight of a modified ethylene/alpha-olefin copolymer, or 50 to 95% by weight of an unmodified ethylene/alpha-olefin copolymer together with a modified ethylene/alpha-olefin copolymer (see, for example, col. 4, lines 15-20). Their fourth adhesive composition also requires a modified ethylene/alpha-olefin copolymer or a modified ethylene homopolymer (see, for example, col. 4, line 66- col. 5, line 3). Their fifth adhesive composition requires 50 to 95% by weight of a modified ethylene/alpha-olefin copolymer or 50 to 95% by weight of an unmodified ethylene/alpha-olefin copolymer and a modified ethylene/alpha-olefin copolymer (see, for example, col. 5, lines 52-67). Each of these combinations have been obviated by the consisting essentially of claim language. It is further submitted that neither Hirose et al., Kawachi et al. nor Tsai, et al, either together or individually, teach or suggest the films of new claims 46-52. Kawachi et al. certainly teach the formation of multilayer films wherein an adhesive layer may be adhered to a polyolefin layer, a polyamide layer, a polystyrene resin layer, an ABS resin layer, a polyacrylonitrile resin layer or an ethylene vinyl acetate copolymer saponified resin layer. However, Kawachi et al. does not teach five layer multilayer films including an outer polypropylene layer, and more particularly, do not teach such five layer films wherein adjacent polymer layers are attached via adhesive tie layers that each comprise both an ethylene/alpha-olefin copolymer and a tackifier. For these reasons, it is

submitted that the rejection has been overcome and should be withdrawn. Such action is requested.

The Examiner has rejected claims 15 and 18 under 35 U.S.C. 103(a) over Hirose et al. It is respectfully submitted that the rejection has been overcome by the instant amendment. As discussed above, Hirose et al. fails to teach or suggest multilayer films including an adhesive tie layer that consists essentially of an unmodified ethylene/alpha-olefin copolymer combined with a tackifier. These arguments apply equally to the limitations presented in dependent claims 15 and 18. For these reasons, it is requested that the rejection be withdrawn.

Applicants submit that the Examiner is looking beyond the teachings of the references. The belief that one skilled in the art **could** form the claimed multilayered film does not suggest that one **should** form such a film to obtain the disclosed benefits. Further, the mere fact that references **can** be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Such a suggestion is absent in each of the references.

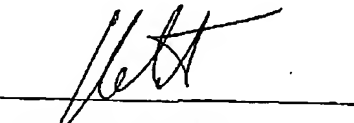
In addition, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schneck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). It is respectfully asserted that the invention as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made.

The Examiner has rejected claims 24-25 and 27 under 35 U.S.C. 103(a) over Hirose, et al. in view of Bennett et al. It is respectfully submitted that the rejection is moot due to the cancellation of claims 24, 25 and 27.

For the foregoing reasons, it is respectfully submitted that the claims are not obvious in view of the Hirose et al., Tsai et al., Kawachi et al. and Bennett et al. references, either alone or in combination. It is therefore requested that each of the rejections be withdrawn.

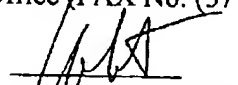
The undersigned respectfully requests re-examination of this application and believes it is now in condition for allowance. Such action is requested. If the Examiner believes there is any matter which prevents allowance of the present application, it is requested that the undersigned be contacted to arrange for an interview which may expedite prosecution.

Respectfully submitted,



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I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office (FAX No. (571) 273-8300) on April 27, 2006.



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